

REMARKS

The claim amendments and remarks herein are responsive to the Office Action dated January 14, 2003. Claims 1-3, 5-11, and 15-17 are pending. Claims 1 and 11 have been amended.

Claim rejections under 35 U.S.C. § 112, second paragraph.

Claims 1, 3, 5-11, and 15-16 stand rejected under 35 U.S.C. § 112, second paragraph as indefinite. Applicant has amended Claims 1 and 11 to recite "a blunting component comprising a shuttle member and a blunting probe mounted on the shuttle member, ...*wherein the blunting probe comprises a hollow tube open only at the ends, and a blunt tip.*" Applicant believes that this amendment does not change the scope of Claim 1 or Claim 11, but expresses the structure of the blunting probe in a different way. Support for these amendments can be found in Applicant's specification at 5:16. In light of these amendments, Applicant respectfully submits that Claims 1, 3, 5-11, and 15-16 are now in compliance with 35 U.S.C. § 112, second paragraph.

Claim rejections under 35 U.S.C. § 103 over Chang *et al.*

Claims 1, 3, 5-9, 12, and 15-17 stand rejected as obvious over U.S. Patent No. 6,391,007 to Chang *et al.* ("Chang *et al.*"). Applicant believes that the Examiner intended to reject Claim 11 rather than Claim 12, which was previously canceled. Accordingly, Applicant's remarks below will be directed to Claim 11.

Claims 1, 3, and 5-9

The Examiner states that "Chang teaches a needle component comprising a housing 501, a needle cannula 502 mounted in the housing, the needle cannula having a sharp tip, wherein the housing defines a fluid chamber 513 and *an access port 509*, and a tubular, non-perforated blunting probe 504 mounted on the shuttle member 515, the blunting member having a blunt tip."

Applicant respectfully points out that component 509 in Chang *et al.* is a flash chamber and not an access port. (See Chang *et al.*, column 6, lines 46-47). Applicant's Claim 1 recites a "housing [that] defines a fluid chamber and an access port for fluid flow therethrough." Chang *et al.* does not describe, teach or suggest "an access port for fluid flow therethrough." In contrast to Applicant's invention embodied in Claim 1, Chang *et al.* only describes a device in which fluid is withdrawn through a catheter hub, not through an access port in the needle apparatus. To establish prima facie obviousness of a claimed invention, all the claim limitations

must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974); MPEP 2143.03. Because every limitation of Applicant's Claim 1 is not disclosed in the cited reference, Applicant respectfully asserts that this rejection is improper.

Chang *et al.* teaches a needle assembly with a solid blunt. Applicant's claims all recite a hollow blunt. Indeed, Chang *et al.* expressly teaches away from the use of hollow blunts. Chang *et al.* discloses that "hollow blunts require extra machining or manufacturing steps in order to produce a satisfactory hollow blunt." (Chang *et al.*, column 1, lines 34-36).

Moreover, Applicant's Claim 1, as amended, recites that the "blunting probe comprises a hollow tube open only at the ends." Replacing the solid probe in Chang *et al.* with a hollow probe open only at the ends would not provide a functional needle apparatus. For example, if Figure 5 in Chang *et al.* was used with a hollow blunt, the open proximal end of the hollow probe would abut the end of the blunt (or shuttle), thereby sealing the end and preventing fluid to flow from the blunt into the flash chamber, producing an unsatisfactory—indeed, inoperative—device. MPEP 2143.01 ("If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.").

In view of the above discussion, one of ordinary skill in the art would not have been motivated to use a hollow blunt with the device disclosed in Chang *et al.*. Thus, Applicant respectfully submits that Claim 1, as amended, is allowable over Chang *et al.* Claims 3 and 5–9 are also allowable over Chang *et al.* because they depend from Claim 1, and further recite independently patentable features. Thus, Applicant respectfully submits that Claims 1, 3, and 5–9 are now in condition for allowance.

Claims 11 and 15–17

Claims 11 recites a "shuttle member defining a fluid chamber and an access port for fluid flow." As with claim 1, claim 11 recites an access port, a feature not described, taught or suggested by Chang et al. Further, Chang *et al.* does not disclose a "shuttle member defining a fluid chamber and an access port for fluid flow." To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974); MPEP 2143.03. Because every limitation

of Applicant's Claim 11 is not disclosed in the cited reference, Applicant respectfully asserts that this rejection is improper.

Claim 11 further recites "a detent and stay engagement between" the needle component and the blunting component, which allows the detent to be moved "between (i) a locking position in which it may bear against the stay and prevent the needle assembly from moving to the sharpened configuration and (ii) an unlocked position which permits the needle assembly to move to the sharpened configuration." In other words, the needle assembly of Claim 11 may be reversibly moved between the locked and unlocked configurations. By contrast, Chang *et al.* does not describe, teach or suggest a device that can reversibly move between locked and unlocked configurations. Chang *et al.* describes only movement from an unlocked, sharpened configuration to a locked, blunted configuration. The ability to reversibly convert the needle assembly from the blunted state to the sharpened state is advantageous for several applications, including catheter applications as described in Applicant's specification at 8:20-21.

In view of the above discussion, Claim 11 is nonobvious over Chang *et al.* Accordingly, Claims 15-17 are nonobvious and patentable over Chang *et al.* because they depend from an allowable base claim and further recite independently patentable features. Thus, Applicant respectfully submits that Claims 11 and 15-17 are now in condition for allowance.

Claim rejections under 35 U.S.C. § 103 over Chang *et al.* in view of Issacson.

Claim 17 stands rejected under 35 U.S.C. § 103 as obvious over Chang *et al.* in view of U.S. Patent No. 6,056,726 to Issacson. Claim 17 is dependent on Claim 11. As discussed above, Claim 11 is allowable over Chang *et al.* Thus, Claim 17, which depends from an allowable base claim is also allowable. Further, neither Chang *et al.* nor Issacson discloses an access port or a shuttle member defining a fluid chamber and an access port for fluid flow. Because every claim limitation is not disclosed in the cited references, Applicant respectfully asserts that this rejection is improper. MPEP 2143.03. Accordingly, Applicant respectfully submits Claim 17 is allowable.

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CONCLUSIONS

For all of the foregoing reasons, Applicant respectfully submits that all of the Examiner's rejections have been overcome and earnestly requests an early allowance of all pending claims. If the Examiner believes that a telephonic conference would expedite the examination of this application, the Examiner is urged to contact the undersigned. Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: Jan 16/03

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